

REMARKS

The foregoing amendments are made to more thoroughly define the subject matter Applicant regards as his invention. Support for the limitation added to claim 1 can be found in the specification at page 7, lines 25 to 27, while support for the new claims can be found in the original claims as well as on page 5, line 29 of the specification.

From the comments contained throughout the Office Action of January 2, 2003, it appears that the Examiner has either entirely missed the Preliminary Amendment filed along with this application on March 20, 2001, or at least misread claim 1 in this Preliminary Amendment.

Claim 1 in the Preliminary Amendment, as well as claim 1 as amended above, does not recite isobutyl isobutyrate ("IBIB") since it expressly states "organic esters having 6 to 10 carbon atoms **other than** isobutyl isobutyrate." (Emphasis added.) Therefore, the double patenting rejection as well as all prior art rejections are not well taken, since they appear to be premised on the notion that the claims recite IBIB.

Moreover, all of the anticipation rejections in the Office Action of January 2, 2003, are improper for the further reason that too much picking, choosing and selecting is required to reach the invention being claimed from the disclosures of the cited references. See, In re Arkley et al., 455 F.2d 586, 172 USPQ 524 (CCPA 1972).

In Arkley, the prior art reference described a genus including many compounds including the compound claimed. However, in order to achieve the claimed compound from this genus, multiple selections of specific substituents from lists of alternatives had to be made. In other words, in a number of places in the generic formula, the disclosure indicated that a number of alternatives could be used. In order to achieve the specific compound claimed from this disclosure, a specific alternative had to be selected in each of these places.

In its decision, the Court stated that such a disclosure did not identically disclose the particular compound being claimed. In particular, the Court stated that:

"... rejections under 35 USC 102 are proper only when the claimed subject matter is identically disclosed or described in "the prior art." Thus, for the instant rejection under 35 USC 102... to have been proper, the Flynn reference must clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing and combining various disclosures not directly related to each other by the teachings of the cited reference." (emphasis added)

Thus, the Court has made clear that generic disclosures implicitly disclosing thousands of different combinations are too unspecific to constitute anticipations under 35 USC §102, at least where multiple selections of alternatives are required to achieve the claimed invention.

In this case, multiple selections from multiple lists of many different alternatives are required to achieve the inventive process as claimed. For example, with respect to the cited Yezrielev et al. Patent, the particular cleaning agents claimed must be selected from the long list of organic chemicals set forth in col. 13, lines 5 to 36. In addition, using these particular organic chemicals for cleaning purposes must be selected from the long list of potential industrial applications set forth, for example, at col. 14, lines 58 to 63. This is precisely the type of picking, choosing and selecting the CCPA has condemned in Arkley. Accordingly, it is clear that the cited Yezrielev et al. Patent and the other cited references are too unspecific to constitute anticipating disclosures under 35 USC §102.

The rejection of claim 11 under 35 USC §112, ¶ 2, is also respectfully traversed. Applicant begins by noting that, since 1976, the PTO has issued some 724,702 U.S. patents including the word "substantially" in one or more claims. Second, Applicant notes that the present invention is directed to producing cleaning compositions which are non-toxic and non-irritating to the skin. That being the case, persons of ordinary skill in the relevant art would have no difficulty in identifying compositions which are "substantially" free of aromatic compounds and alkali metal hydroxides, as claimed.

If any additional fees are due with this Amendment, please charge our Deposit Account No. 03-0172.

Respectfully submitted,



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